



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,696	06/25/2001	Steve Alister Nixon	ACO 2799 US	1033

7590 06/20/2003
David H. Vickrey
Akzo Nobel Inc.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

13
EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,696

Applicant(s)

NIXON, STEVE ALISTER

Examiner

Margaret G. Moore

Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4, 9 to 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 9 to 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1712

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in EPO on 6/23/2000. It is noted, however, that applicant has not filed a certified copy of the EP application as required by 35 U.S.C. 119(b).
2. Claims 9 to 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: any and all steps that are included in the method.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 1, 2, 9, 10, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaki et al.

For the record, the Examiner notes that "curable with a curing agent consisting essentially of atmospheric moisture and/or water" carries little weight in this claim. First, note that this merely requires that the composition is *able* to cure in this manner. To anticipate the claim, it does not need to cure in this manner. Also note that the phrase "consisting essentially of" allows for the inclusion of other curing agents that do not materially affect the basic and novel characteristics of the invention. Since any additional curing agent will merely aid in accelerating curing, this does not appear to materially affect the basic and novel characteristics of the claimed invention.

Yamaki et al. teach a curable composition used to coat various substrates as taught on column 16. This composition includes an acrylic polymer containing alkoxy-silyl groups and a polydiorganosiloxane having silanol termination. In the working examples, see Components C-1 and C-3 which meet the claimed polysiloxane component. Note component E which meets the amino compound in claim 2. Note too components B-1 to B-4 which meet the claimed acrylic polymer. As can be seen on Tables 1 and 2, many of the compositions prepared by Yamaki et al. anticipate the

Art Unit: 1712

instant claims. In addition note Comparative Example 1 which does not include the aminosilane.

Note the top of column 12 which indicates that the curing catalyst *accelerates* condensation, indicating that this composition is *curable* without the catalyst.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaki et al.

Yamaki et al. do not prepare the acrylic polymer in the presence of a polysiloxane. However this is a product by process claim, and the product, an acrylic polymer having alkoxysilyl functional groups, appears to be inherently the same regardless of the method by which it is prepared. As such, it would appear that the composition of claims 3 and 4 is inherently the same as that taught by Yamaki et al.

7. Nambu et al. is cited as being of general interest. This reference anticipates and/or suggests at least some of the claims, but is not considered to be any closer to the claimed invention than Yamaki et al. The Examiner did not make a rejection over Nambu et al. at this time to avoid redundancy.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers

Art Unit: 1712

for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret S. Moore
Primary Examiner
Art Unit 1712

mgm
December 16, 2002